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**COPY MAILED**

**AUG 05 2008**

In re Application of	:	
Durbin, et al.	:	
Application No. 09/681,017	:	
Filed: November 22, 2000	:	ON PETITION
Attorney Docket No. GEMS8081.023	:	
For: METHOD AND SYSTEM TO REMOTELY	:	
ENABLE SOFTWARE-BASED OPTIONS FOR	:	
A TRIAL PERIOD	:	

This is a decision on the petition, filed May 12, 2008, under 37 CFR 1.183 to waive the necessity for the signatures of all joint inventors on a 37 CFR 1.131 declaration, the petition under 37 CFR 1.48(a) to correct the inventorship of the above-identified application by the addition of four joint inventors, and the constructive petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a)(3), which requires submission of an oath or declaration signed by the actual inventors.

The petition under 37 CFR 1.183 to waive 37 CFR 1.131 is **dismissed**.

The petition under 37 CFR 1.48(a) is **dismissed**.

The constructive petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a)(3) is **dismissed**. A \$400.00 petition fee will be charged to petitioners' deposit account.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. FAILURE TO TIMELY RENEW THE PETITION WILL RESULT IN ABANDONMENT. The reconsideration request should include a cover letter entitled "Renewed Petitions under 37 CFR §§ 1.48 and 1.183.

A declaration, filed on February 12, 2001, listed three joint inventors: Winnie Durbin, Kun Zhang, and Karamjeet Singh.

Petitioners wish to add David T. Mehring, Thomas L. Lamoureux, Hubert A. Zettel, and Timothy D. Butler as joint inventors.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a petition setting forth the desired change in inventorship, (2) including a statement from each person being added and from each person being deleted as an inventor that the error occurred

without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (4) the fee set forth in 37 CFR 1.17 (i); and (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The petitions of record lack compliance with item (3). The declaration filed on May 12, 2008 lacks signatures from the original three joint inventors. Inventor Zhang's execution is excused because it has been established that he cannot be located. See petition decision, October 12, 2007, Page 1.

The petition under 37 CFR 1.183 requesting waiver of the execution of the declaration for patent application by Inventors Singh and Durbin is evaluated as to whether the non-signing inventors were actually given the opportunity to execute the oath or declaration, or whether the non-signing inventors could not be reached. In essence, petitioners must show that the inability to again obtain an executed declaration from the non-signing inventors is, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond their control.

Petitioners have not established that Inventors Singh and Durbin have refused to execute a declaration for the patent application.

With respect to Inventor Singh: He has admitted that he is a joint inventor. It has been established that he was unwilling to execute the 131 declaration presented to him in February 2007. However, his unwillingness to execute the 131 declaration presented to him in February 2007 does not prove that he would refuse to sign a declaration that lists him as a joint inventor.

With respect to Inventor Durbin: Inventor Durbin has not refused to cooperate. Her husband cannot refuse to cooperate on her behalf.

Petitioners should mail a copy of the complete application papers (specification, claims and drawings) and the May 12, 2008 declaration to the last known addresses of Inventors Singh and Durbin, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc. *See* MPEP 409.03(d).

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration **by the party to whom the refusal was made**. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by petitioners that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Petitioners are informed that emailing is generally not accepted as a means to communicate with non-signing inventors. This is because the Office cannot know definitely if the message was received; people are not as careful in deleting e-mails as they are in throwing out mail as shown by bulk folder deletions and the fact that some people might not check emails frequently; the Office does not know if the recipient has the program to open the specific attachment; and PTO guidelines regarding accepting email reflects the fact that the Office does not have the same confidence in email as it does in postal service.

The Office typically requires documentary evidence of successful e-mailing in the form of a response email from the non-signing inventor in which the inventor acknowledges receipt of the email and his ability to read the attachments. Sending an email alone is not sufficient.

The petition requesting waiver under 37 CFR 1.183 of the requirement in 37 CFR 1.48(a)(3) for the execution of the new declaration for patent application by Inventors Singh and Durbin cannot be granted at this time. For this reason, the petition under 37 CFR 1.48(a) is dismissed, as well.

Petitioners assert that the three original joint inventors have either refused to join in the execution of a declaration under 37 CFR 1.131 or cannot be located. It has been established that Inventor Zhang cannot be located. However, petitioners have not established that Inventors Durbin and Singh have refused to execute the May 12, 2008 declaration under 37 CFR 1.131. With respect to Inventor Singh: He was unwilling to execute the 131 declaration presented to him in February 2007. The Rule 131 declaration presented to him in February 2007 and filed in the Office on March 26, 2007 differs from the Rule 131 declaration filed in the Office on May 12, 2008. Thus, he has not refused to sign the May 12, 2008 Rule 131 declaration. He has not been presented with the May 12, 2008 Rule 131 declaration. With respect to Inventor Durbin: She has not refused to sign the May 12, 2008 Rule 131 declaration. Her husband cannot refuse on her behalf.

Both joint inventors should be mailed a copy of the May 12, 2008 Rule 131 declaration to their last known addresses, return receipt requested. A cover letter of instructions should accompany the mailing of the Rule 131 declaration setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc. *See* MPEP 409.03(d).

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration **by the party to whom the refusal was made**. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by petitioners that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there

is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the Rule 131 declaration, that reason should be stated in the affidavit or declaration.

In short, Inventors Singh and Durbin should be mailed a copy of the application, along with a copy of the May 12, 2008 declaration for patent application and a copy of the May 12, 2008 Rule 131 declaration for their execution. When petitioners can show that Inventors Singh and Durbin were successfully mailed or received the aforementioned documents and that they either refused to sign the declarations or did not respond to the request that they sign the declarations within a reasonable amount of time, petitioners will have satisfied this requirement.


Further correspondence with respect to this matter should be addressed as follows:

By mail:        Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By facsimile: (571) 273-8300  
                  Attn: Office of Petitions

By hand:        U.S. Patent and Trademark Office  
                  Customer Service Window  
                  Randolph Building  
                  401 Dulany Street  
                  Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3230.

  
Shirene Willis Brantley  
Senior Petitions Attorney  
Office of Petitions